

### **REMARKS**

Applicant has reviewed the Office Action dated December 4, 2002.

Claims 2, 6, 8 - 10, 13 - 15, 23 and 30 are amended, and claims 1, 3, 4, 5, 7, 28 and 29 are canceled; as a result, claims 2, 6, 8-11, 13-15, 23-26 and 30 are now pending in this application.

#### **Election/Restrictions**

Claims 28 and 29 were withdrawn from consideration by the Examiner as being directed to a non-elected invention.

Applicant has canceled the claims without prejudice, but reserves the right to reintroduce them in a divisional application at a later date.

#### **Allowable Subject Matter**

Applicant acknowledges the allowance of claim 15. The claim was amended to clarify the recited subject matter.

#### **§112 Rejection of the Claims**

In the Office Action, claim 13 was rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 13 has been amended to correct the claim dependency. The amendment is for clarification only and is non-narrowing.

#### **§102 Rejection of the Claims**

In the Office Action, claims 1, 3 and 4 were rejected under 35 USC § 102(e) as being anticipated by Weijand (U.S. Patent No. 6,298,271).

Claims 1, 3 and 4 have been cancelled without prejudice.

*§103 Rejection of the Claims*

In the Office Action, claims 2, 8 – 11, 13 and 14 were rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Zarinetchi et al (U.S. Patent No. 6,389,318).

Claims 2, 8-10, 13 and 14 have been amended to make claims 2, 8 – 11, 13 and 14 ultimately dependent on allowed claim 15. They are each allowable for the same reason as base claim 15. Applicant respectfully requests withdrawal of the rejection and allowance of claims 2, 8 – 11, 13 and 14 as amended.

In the Office Action, claims 5, 6 and 23 were rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Silvian (U.S. Patent No. 6,301,504).

Claim 5 has been cancelled, and claims 6 and 23 have been amended.

As to amended claim 6, the claim is now dependent on allowable claim 15 and is therefore allowable.

As to amended claim 23, the Office Action fails to make out a proper *prima facie* case of obviousness required under 35 USC § 103(a) because the Office Action does not provide a motivation or suggestion to combine the cited documents (see M.P.E.P. § 2142).

Even if a motivation to combine had been shown, the proposed combination of documents fails to describe all the elements recited in the claim. The claim as amended includes, among other things, “where the conductive loops are positioned around the central core to form a substantially constant gap between adjacent loops.” Applicant is unable to find the element described or suggested in the cited portions of the patents from which the proposed combination was constructed.

Applicant respectfully requests withdrawal of the rejection and consideration and allowance of claims 6 and 23.

Claim 7, which was rejected in the Office Action under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Kung (U.S. Patent No. 6,400,991), has been cancelled.

In the Office Action, claims 24-26 were rejected under 35 USC § 103(a). Claim 24 was rejected as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Silvian (U.S. Patent No. 6,301,504) and further in view of Kung (U.S. Patent No. 6,400,991), and claims 25 and 26 were rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Silvian (U.S. Patent No. 6,301,504) and further in view of Zarinetchi et al (U.S. Patent No. 6,389,318).

Applicant respectfully traverses the rejection. Claims 24-26 are ultimately dependent on claim 23 and are believed to be allowable for the reasons stated previously for amended claim 23.

In the Office Action, claim 30 was rejected under 35 USC § 103(a) as being unpatentable over Weijand (U.S. Patent No. 6,298,271) in view of Snell et al. (U.S. Patent No. 6,424,867).

Claim 30 has been rewritten into independent form incorporating the limitations of cancelled claim 1.

Applicant respectfully traverses the rejection to claim 30. The Office Action fails to make out proper *prima facie* obviousness because the documents do not contain a motivation to make the proposed combination. A motivation to make the combination must come from the cited documents and not from hindsight due to the Applicant's disclosure.

The telemetry antennas discussed in Weijand relate to an external programmer. The telemetry circuits discussed in Snell are internal to an implantable device and are for running two communication protocols. Such circuits define information in a stream of data being transmitted. Each circuit runs different encoding schemes, transmission rates, or access codes (see col.3 lines 40-53). These circuits are not analogous to an antenna designed to operate at a specific transmission frequency. Because Snell is concerned with protocol circuits of an implantable device and Weijand is concerned with telemetry antennas of an external programmer, the motivation for the combination does not appear to come from the documents themselves and the Office Action does not suggest any reason for combining the two documents, save hindsight.

Also, the Office Action fails to make out proper *prima facie* obviousness because the proposed combination of documents fails to describe the elements recited in amended claim 30. As stated previously, the cited portions of Snell relate to two telemetry circuits within an

implantable device and each telemetry circuit is for using a different communication protocol, while the cited portions of Weijand relate to two antennas designed to remove far field effects. Thus, Applicant is unable to find in the proposed combination, “a first and a second telemetry coil concentrically planarly wound substantially in a common plane and each adapted to inductively couple with the implanted medical device, where the second telemetry coil is constructed and arranged to operate at a different telemetry operational frequency than the first telemetry coil,” as recited in part in amended claim 30.

Applicant respectfully submits that amended claim 30 is not obvious in view of the proposed combination and Applicant requests withdrawal of the rejection and allowance of amended claim 30.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6912) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 4 day of March, 2003.

Name

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